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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,462	10/21/2003	James P. Snyder	007157/270549	4831
826	7590	07/25/2007	EXAMINER BALASUBRAMANIAN, VENKATARAMAN	
ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000			ART UNIT 1624	PAPER NUMBER
			MAIL DATE 07/25/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/690,462	SNYDER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	/Venkataraman Balasubramanian/	1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 09 May 2007.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 13-16,20,23,26-30,33,36-38,42 and 52 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 13-16,20,26-30,33,36-38,42 and 52 is/are allowed.
- 6) Claim(s) 23 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_

Art Unit: 1624

## DETAILED ACTION

The applicants' response filed on 5/9/2007 is made of record. Claims 13-16, 20, 23, 26-30, 33, 36-38, 42 and 52 are pending.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Desiraju et al. et al. Indian Journal of Chemistry. 27B(10): 953-954, 1988.

See compound 1d shown on page 953.

Thus, it would be obvious to one trained in the art to make pharmaceutical composition of the said compound.

This rejection is same as made in the previous office action but now relies on the original article.

Desiraju et al., teaches that compounds of formula I are from cyclopentanone and then the product is subsequently subject to dehydrogenation to obtain the unsaturated analog. See first paragraph last three lines, and column 2, second paragraph. Note Desiraju et al., states "In the case of dipyridyl derivative (1d) the above method was not successful since bromination of the corresponding cyclopentanone was difficult. So 1d was prepared directly from the corresponding cyclopentanone by dehydrogenation with chloranil in refluxing xylene."

A given a compound it would be obvious one trained in the art to make its composition including pharmaceutical composition. Instant IDS has several references teaching biological activity of dibenzylidene cyclohexanones and related unsaturated ketones (see entry 16 and 17). Hence, contrary to applicants urging it would be obvious to one trained in the art that such compounds will have biological activity and hence he will be motivated to make a pharmaceutical composition.

Claim 23 is rejected 35 U.S.C. 103(a) as being unpatentable over Katritzky et al. Journal of Heterocyclic Chemistry 25(5), 1321-1325.

See compound 1 shown in page 1321 in the Scheme 1. See entire document for details of these compounds .Especially see process of making of compound Ia shown in page 1325 under EXPERIMENTAL. Note the said compound is recrystallized from ethanol a solvent suitable for pharmaceutical use.

Thus, it would be obvious to one trained in the art to make pharmaceutical composition of the said compounds.

Applicants' argument to overcome this rejection is not persuasive. A given a compound it would be obvious one trained in the art to make its composition including pharmaceutical composition. Instant IDS has several references teaching biological activity of dibenzylidene cyclohexanones and related unsaturated ketones (see entry 16 and 17). Hence, contrary to applicants urging it would be obvious to one trained in the art that such compounds will have biological activity and hence he will be motivated to make a pharmaceutical composition.

#### ***Allowable Subject Matter***

Claims 13-16, 20, 26-30, 33, 36-38, 42 and 52 are allowed.

#### **Conclusion**

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (571) 272-0662. The examiner can normally be reached on Monday through Thursday from 8.00 AM to 6.00 PM. The Supervisory Patent Examiner (SPE) of the art unit 1624 is James O. Wilson, whose telephone number is 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned (571) 273-8300. Any

inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAG. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-2 17-9197 (toll-free).

*Venkataraman Balasubramanian*  
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7/23/2007